

### **REMARKS**

Claims 16 and 27 have been amended. Claims 16-27 are pending.

In the recent most Office action, The Examiner has objected to both Claim 16. Claim 27 was rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the invention. Claims 16-25 have been rejected under 35 U.S.C. 103(a) as unpatentable over Anderson (US 5,624,213) in view of Despres (US 6,641,338). Claim 26 has rejected under 35 U.S.C. 103(a) as unpatentable over Thauesen (US 5,967,709) in view of Despres (US 6,641,338). Claim 27 has rejected under 35 U.S.C. 103(a) as unpatentable over Thauesen (US 5,967,709) in view of Despres (US 6,641,338).

Applicant herewith submits modifications to the claims in accordance with suggestions and directions provided by the Examiner which are believed to address each of the objections and rejections raised. Applicant, respectfully, traverses all grounds of rejection to the extent they are applied to the currently pending claims for the reasons which follow as well as explanations for the modifications to the claims and needed to address the objections raised.

#### **Objections to Claims:**

Claim 16 has been amended to more clearly define the invention, as shown in the listing of the currently pending claims.

#### **Rejection under 35 U.S.C. 112, second paragraph:**

The Examiner had rejected claim 27 as failing to particularly point out and distinctly claiming the invention. Applicant has amended the claim as suggested by the Examiner and that this rejection is now avoided.

**Rejections under 35 USC 103(a):**

**The rejection of claim 16:**

At pages 3-4 of the Office action of May 15, 2008, the Examiner has set forth the basis for rejection of claim 5 as being unpatentable over Anderson ('213) when taken in view of Despres (6641338).

As previously noted, the Examiner acknowledges that Anderson ('213) does not teach a hole saw boss having a first and second portions with diameters in a stepped down configuration. However, the Examiner cites Despres ('338) as showing a hole saw boss having a first and second portions with diameters in a stepped down configuration. The Examiner concludes that "it would have been obvious to one of ordinary skill in the art to modify the hole saw boss of Anderson '213 to include a stepped down boss configuration as taught by Despres '338 to accommodate different sized attachment bore sizes exhibited on commonly constructed hole saws with various cutting diameters."

As mentioned in the response to the Previous Office Action, applicant would note that claim 16 includes the limitation relating to saw boss wherein "said second threaded member being of a stepped down diameter to accommodate a hole saw having a threaded bore diameter smaller than the first hole saw" requires not only a step down arrangement but also requires that both portions be **threaded**. Neither Anderson or Despres teach or disclose such an arrangement which is threaded to accommodate two separate saw blades. It does not readily appear, therefore that a person skilled in the art would necessarily have arrived at the presently claimed invention, simply by combining the Anderson and the Despres documents. Neither of these patents involve the use of a threaded member of stepped down cross sectional size for accommodating two hole saws of different diameter at any one time in a simple and effective manner. It is indeed this feature which makes the invention useful in the problem specified, that is,

enlarging existing holes in a workpiece. Even though the Despres patent teaches the possibility of mounting differently shaped hole saws to the arbor, it is intended that only one hole saw be fixed thereto at once. The patent appears to relate specifically to a means of removing portions of workpiece from within the hole saw cup after use. This does not appear possible when two hole saws are fitted to the drill at any one time. The Anderson patent does teach the use of two hole saws, however, it does not include the stepped down threaded portion diameter as claimed and is therefore again, irrelevant. On this basis, we submit that none of the patents, when taken alone or in combination, preclude the present invention of novelty or inventive step. Furthermore, the Despres patent requires hole saw cups that are manufactured specifically for that product so that they may be lockingly engaged by the front or rear boss of the hole saw arbor holder. The patent discloses a distinct locking mechanism between the hole saw cups and the arbor involving transverse grooves. It is not readily apparent that it would even be possible to modify the device of Anderson using a portion from Despres in a manner likely to provide a working saw boss, and definitely not in a manner to arrive at the claimed invention. Therefore overall, the Despres patent discloses a quite complex and what looks to be an expensive hole saw locking apparatus. In contrast, the hole saw boss of the present invention avoids such complex designs in that it utilizes threaded portions which are sized and configured to accommodate commonly available hole saw threaded bores. In particular, the hole saw boss is able to accommodate hole saw cups which are currently available on the market and configured to be fitted to conventional hole saw bosses. This provides a useful result in that consumers are not required to spend additional money on purpose built hole saw cups.

Again, Applicant requests reconsideration of this rejection, for the following reasons:

1. There is no justification, in Anderson and Despres or in any other prior art separate from the Applicant's disclosure, which suggest that these references be combined, much less combined in the manner proposed.

2. Even if Anderson and Despres were to be combined in the manner proposed, the proposed combination would not show all of the novel physical features of Claim 16 as amended.
3. These novel physical features of Claim 16 produce new and unexpected results and hence are unobvious and patentable over these references.

**Rejection of claim 26:**

At page 4 of the Office action of May 15, 2008, the Examiner has set forth the reasoning and basis for rejecting claim 26 under 35 U.S.C. 103(a) as unpatentable over Thuesen (US5967709) in view of Despres (US6641338). Again, the Examiner has not given any acceptable reason in the Office action to support the proposed combination. As previously mentioned in the response to the Office Action, the fact that the cited references teach some elements of the inventions is not sufficient to gratuitously and selectively suggest that the one would be led to substitute parts of one reference for a part of another reference in order to meet applicants' novel claimed combination.

The references relied upon fail to provide an adequate basis in evidence to support the Examiner's initial conclusion of obviousness. In short there must be more than merely establishing that the individual components exist in the prior art. There must be something, found in the prior art which would have suggested, led or motivated one skilled in this art to bring those individual components together in the manner presently claimed. The present rejection lacks this aspect.

Again, Applicant requests reconsideration of this rejection, for the following reasons:

1. There is no justification, in Thuesen and Despres or in any other prior art separate from the Applicant's disclosure, which suggest that these references be combined, much less combined in the manner proposed.
2. Even if Thuesen and Despres were to be combined in the manner proposed, the proposed combination would not show all of the novel physical features of

Claim 26 as amended.

3. These novel physical features of Claim 26 produce new and unexpected results and hence are unobvious and patentable over these references.

Applicants respectfully request, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. § 706.02. Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a "factual basis to support his conclusion that would have been obvious" to make the combination.

**Rejection of claim 27:**

At page 5 of the Office action of May 15, 2008, the Examiner has set forth the reasoning and basis for rejecting claim 27 under 35 U.S.C. 103(a) as unpatentable over Thuesen (US5967709) in view of Despres (US6641338). Again, the Examiner has not given any acceptable reason in the Office action to support the proposed combination. As previously mentioned in the response to the Office Action, the fact that the cited references teach some elements of the inventions is not sufficient to gratuitously and selectively suggest that the one would be led to substitute parts of one reference for a part of another reference in order to meet applicants' novel claimed combination.

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The applicant would like to bring the attention of the examiner that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. As mentioned above, none of references cited by the Examiner alone or in combination would have made the whole invention obvious over the prior art. The Supreme Court's decision in *KSR International. Co. v. Teleflex, Inc., et al.*, 550 U.S.(2007) requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." (KSR Opinion at p. 14). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," (KSR Opinion at p. 15). And, the Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." (KSR Opinion at p. 14). Anything less than such an explicit analysis may not be sufficient to support a *prima facie* case of obviousness. In January 2008 BPAI decision entitled *In re Wada and Murphy* reversed a § 103 rejection because the Examiner did not explain where or how cited art taught or suggested all of the features of a claimed invention.

As noted above that the Office Action fails to specifically address even the

expressly recited features of the pending independent and dependent claims. Under the Office's policy of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application. (MPEP §707.07(g)). It is submitted that the present application is not sufficiently informal, does not present an undue multiplicity of claims, or exhibit a misjoinder of inventions, so as to reasonably preclude a complete action on the merits. Thus, it is submitted that the Office's failure constitutes a failure to expeditiously provide the information necessary to resolve issues related to patentability that prevents the Applicant from, for example, presenting appropriate patentability arguments and/or rebuttal evidence. (See The Official Gazette Notice of November 7, 2003). Additionally, it is submitted that the Office's failure needlessly encourages piecemeal prosecution, which is to be avoided as much as possible. (MPEP §707.07(g)). Accordingly, in the event that the Office maintains the rejection of any of the independent and/or dependent claims, Applicant respectfully requests, in the interests of compact prosecution, that the Office apply art against each feature of each rejected independent and dependent claims, on the record, and with specificity sufficient to support a prima facie case of obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in *In re Sernaker*, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantages to be derived from combining their teachings." That the suggestion to combine the references should not come from applicant was forcefully stated in *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

"It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve

the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here

the PTO].” As was further stated in *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself

... *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied.]

In line with these decisions, the Board stated in *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the, applied references in the proposed manner to arrive at the claimed invention. ...

That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of the ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual ‘to combine the relevant teachings of the references.’ ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”



### **Conclusion**

In conclusion, applicant has presented arguments and amendments relating to both the grounds of objection and the grounds of rejection set forth in the Office action of May 15, 2008. Applicant, respectfully, requests that the Examiner reconsider these objections and rejections and find all claims allowable.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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